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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/023,750 | 12/21/2001 | Masanori Aritomi | 35.C16049 | 5081 |

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EXAMINER

RUDOLPH, VINCENT M

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| ART UNIT | PAPER NUMBER |
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2624

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/023,750 | ARITOMI, MASANORI | |
| | Examiner | Art Unit | |
| | Vincent M. Rudolph | 2624 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 17 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 32 and 36-37 are rejected under 35 U.S.C. 102(b) as being unpatentable by Hicks ('353).

Regarding claim 37, Hicks ('353) discloses a print control apparatus (printing system, See Figure 1) which operates to print presentation material (Transparencies, See Figure 3) and distribution material (Handout Set, See Figure 3) that includes a job issue unit adapted to issue a print job according to the print settings determined by the user (the user interface issues the print job whenever printing is ordered by the user, See Col. 10, Line 14-16) as well as a judgment unit (touch screen, See Figure 2) to tell whether or not the print settings set by the user corresponds to the presentation mode (the user selects whether to have the transparencies as an output or not, See Col. 7, Line 4-10). There is also a unit adapted to execute ordinary print process when it is judged that the print setting does not correspond to the presentation mode (if the user does not select the transparencies screen button, the presentation mode is not outputted, and instead, regular printing is done, See Figure 2; Col. 7, Line 4-6), since it is a color electrophotographic printing/copying machine, See Col. 6, Line 50-53). When it is determined though that the print settings corresponds to the presentation mode, a

command is added to the presentation mode, which designates the presentation mode (the transparencies settings, See Figure 3), the number of copies of the distribution material (the quantity, See Figure 3), and a color setting command of the distribution material (the color setting of the handout set, See Figure 3), and execute the presentation-mode print process within one job (once the user sets the sequence to output the presentation print process, the job is outputted together, See Col. 9, Line 58-60).

Regarding claims 32 and 36, the rationale provided in the rejection of claim 37 is incorporated herein. In addition, the print control apparatus of claim 37 corresponds to the method of claim 32 and the computer-readable storage medium of claim of claim 36 and provides the steps disclosed herein.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 33-35 and 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks ('353) in view of Simpson (Pub. # 20020066989) and Sagman.

Regarding claim 38, Hicks ('353) discloses that whenever the presentation-mode print process is executed (the user selects transparencies as the designated output, See Col. 7, Line 7-10) the print control apparatus (printing system, See Figure 1) also includes a unit to execute the color setting of the presentation material (the user selects

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the different options for color, See Figure 3; Col. 7, Line 42-45), a unit adapted to print the presentation material (the electrophotographic printing/copying machine, See Figure 1; Col. 6, Line 50-53), a unit to set the number of copies set for the distribution material (the quantity for the sets, See the number set for Quantity within Figure 3; Col. 9, Line 58-60), a unit adapted to print the distribution material based on the color setting and the number of print sets (the user selects the color for the handout sets, See Figure 3; Col. 7, Line 64-67, and the quantity to be printed, See Col. 9, Line 58-60).

Hicks ('353) does not disclose a unit to temporarily store print data of the print job in a memory of the print device, and a unit to execute an N-in-1 layout process for the distribution material.

Simpson (Pub. # 20020066989) discloses memory (See Figure 1, Element 130) within the printer (See Figure 1, Element 110) to store the document (the memory stores the document in the print ready form, See Page 2, Paragraph 0016).

Sagman discloses within Microsoft Power Point, a user can select a an N-in-1 layout process for the distribution material, such as a predetermined number of pages to be put onto one recording paper and distribute it as a handout.

It would have been obvious to one skilled in the art at the time of invention by the applicant to have the memory within the print device as described by Simpson (Pub. # 20020066989) and also the N-in-1 layout process as described by Sagman and incorporate it into the multi-function printing apparatus of Hicks ('353). By including memory, such as RAM, within the printer allows any settings the user changed to be saved in case any other modifications need to be included prior to printing the

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document. Also, adding a predetermined number of pages to print out onto one recording paper, it gives people room to put notes down for each slide of the distribution material.

Regarding claim 39, Hicks ('353) discloses each unit that executes the color setting for the presentation material (transparencies, See Figure 3) and the distribution material (handout set, See Figure 3) is adapted to select either monochrome (black and white) or color printing (the user is able to select the color setting for the each material prior to printing the set, See Figure 3; Col. 7, Line 43-46 and Line 65-67).

Regarding claim 40, Hicks ('353) discloses the print control apparatus also includes a stapling execution unit such that the unit adapted to print the presentation material executes printing on a transparent sheet and even though it is instructed to execute stapling, the presentation material is not stapled together, but the distribution material is (the handout sets can be stapled together using a stapler, See Col. 10, Line 19-22) but since the presentation material is shown one-by-one on a projector, it cannot be stapled together.

Regarding claims 33-35, the rationale provided in the rejection of claims 38-40 is incorporated herein respectively. In addition, the print control apparatus of claims 38-40 corresponds to the method of claims 33-35 and provides the steps disclosed herein, respectively.

Response to Arguments

Applicant discloses that the combination of Hicks ('353) and Sagman neither disclose nor suggest a command particular to the presentation mode is added to an

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issued job, such as a command to designate the presentation mode, the number of copies of the distribution material, and a color setting of the distribution material. Hicks ('353) discloses that by selecting the transparencies (presentation mode), the user is presented with additional commands in order to properly output the material however the user wishes. For example, the user is able to select the designate the presentation mode (select any transparency settings, See Figure 3), a color setting for the handout set (distribution material, See Figure 3), any additional sheets for the handout set and a total quantity for the presentation material (See Figure 3). Thus, Hicks ('353) is able to overcome all the limitations the applicant discloses within the invention. Based on the facts, this action is made final.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Tonkin ('702) and Han (Pub. # 20030103237).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vincent M. Rudolph whose telephone number is (571) 272-8243. The examiner can normally be reached on Monday through Friday 8 A.M. - 4:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vincent M. Rudolph
Examiner
Art Unit 2624

A handwritten signature in cursive script, appearing to read "Mark Zimmerman", with a long horizontal flourish extending to the right.

MARK ZIMMERMAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600